



UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/554,704	11/07/95	WOOLSTON	T 100CIP

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ECM1/1016

EXAMINER	
WEINHARDT, R	
ART UNIT	PAPER NUMBER
2411	11

DATE MAILED: 10/16/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 7/17/97

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-32 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 12-18 is/are allowed.

☒ Claim(s) 1-11 + 19-32 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

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## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because the "black boxes" in fig 1. are required to be labeled. Correction is required.
2. Applicant is required to submit a proposed drawing correction in response to this Office action. However, formal correction of the noted defect(s) can be deferred until the application is allowed by the examiner.

### ***Claim Rejections - 35 USC § 112***

3. Claims 1-9, 11 and 19-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "said database server" appearing in the third line from the bottom lacks clear antecedent basis. Further, it is not clear how the database can store information from said record of a good as it is connected to the "posting handler" wherein this handler is merely recited as processing a "posting request" that is not clearly associated with the created record of the good. Finally, with respect to communication regarding the binding offer to sell, it is not clear where this is communicated to as the posting handler again processes a "posting request", not an

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offer to sell, nor is there means to provide the processing for withdrawing the binding offer as communicated by the posting/de-posting terminal.

In claims 6 and 11, it is not clear what is implied by reciting a "posting/de-posting" terminal as no de-posting operations are found. While claim 11 recites withdrawing the binding offer, this is recited with respect to the market maker computer, not the "posting/de-posting terminals".

Further, in claim 11, it is not clear how a market is created by the method when the binding offer appears to always be withdrawn.

In claim 19, the phrase "An electronic market for goods apparatus" is not clear. Further, with respect to the presentation mapping module "said market for goods" lacks clear antecedent basis.

Dependent claims not specifically mentioned above are rejected because by their dependence they include the language of a rejected base claim.

### ***Double Patenting***

4. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985) *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 6-7 and 26-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6, 13 and 21-28 of copending Application No. 08/427,820. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of different terminology does not present a clear line of demarcation.

Claims 6-7 and 26-32 of the instant application essentially recite methods for establishing an electronic market for goods using terminals and a market maker computer including creating a data record, transferring the data record to the market maker computer, displaying the record to a participant, clearing financial payment and transferring legal title and posting a second price. Claim 6 of the copending application calls for posting goods on a market maker computer by creating a data record, displaying the record to a participant, processing an order to buy including transferring ownership and posting a new offer price. As supported by the instant specification, processing a buy order is seen to include clearing financial payment and transferring ownership effectively includes transferring legal title.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-9, 11 and 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindsey et al. '383 in view of Lalonde et al. and Fujisaki.

Lindsey et al. teach a trading system that creates a computerized market for commodities. In the system of Lindsey, a unique electronic title for an item is created and information on that item is posted on a central computer. Buyer terminals are used to access the information at the central computer and purchase selected items. Lindsey teaches the use of electronic funds transfer in processing purchases. Lindsey further teaches transferring title of the item from the seller to the purchaser, keeping a record of the transaction and that the item can be traded multiple times inside the trading system. Lindsey also teaches printing of title data. See the abstract, figs. 1-3g,

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col. 1 lines 10-13, the summary of the invention, col. 3 lines 40-44, col. 6 lines 47-68, col. 22 line 22 to col. 24 line 32, col. 27 lines 35-42 of Lindsey.

While the preferred embodiment of Lindsey is directed to cotton bales, Lindsey does teach other commodities or goods can be sold with this system. Although Lindsey does not specifically teach that the other goods are necessarily "used or collectable" goods, Lalonde et al. teach a computer-based system for posting goods for sale for electronic review by buyers where the system can be applied to "any field in which conventional classified ads are useful", which inherently includes used and collectable goods. . As the system of Lindsey provides security against fraud in the marketing of goods and as the goods posted within the system of Lalonde would have obviously benefited from the same protection, it would have been obvious to those of ordinary skill in the art to modify the teachings of Lindsey to include used and collectable goods. Lalonde also teach searching the posted goods to match buyers with sellers, which provides the obvious advantage of efficiency. As a result, it would have been obvious to those of ordinary skill in the art to modify the teachings of Lindsey to include matching as taught by Lalonde. See the abstract and col. 3 lines 40-51 of Lalonde

With respect to the provision of digital images of the goods for sale, the capture and presentation thereof is well known in the art and would have been obvious to those of ordinary skill in the art for the recognized advantage of allowing the buyer to view the item prior to purchase. See Fujisaki, specifically, the abstract, figs. 1 and 23(A)-(E).

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The use of common, well known transmission protocols to transmit the data would have been obvious to those of ordinary skill in the art for the obvious advantage of using off the shelf hardware and software. As for claim 10, having a retail price and a wholesale price for an item is well known. The dealer price is lower than the customer price as such difference is needed to make the transaction profitable to the dealer. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included both the retail and wholesale price for record keeping as well as to computer the profits earned by the dealer.

With respect to claims 30-32, as mentioned above, Lindsey provides a unique code and prints title data. Further, the use of bar codes is well known and would have been obvious to those of ordinary skill in the art. Finally, with respect to the withdraw of an offer to sell, as this is well known to be done by hand in existing markets, it would have been obvious to those of ordinary skill in the art to modify the teachings of Lindsey and Lalonde to include such withdrawal for the obvious benefits to the owner of the goods and the convenience afforded by it's automation. See *In re Venner*, 120 USPQ 192.

***Allowable Subject Matter***

8. Claims 12-18 are allowed.

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9. Claims 19-25 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action.

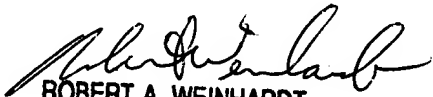
**Conclusion**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Weinhardt whose telephone number is (703) 305-9780. The examiner can normally be reached on Monday-Friday from 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes, can be reached on (703) 305-9711. Facsimile transmissions to this Group may be directed to (703) 308-5356 or 5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

October 13, 1997

  
ROBERT A. WEINHARDT  
PRIMARY EXAMINER  
GROUP 2400